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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,727	03/04/2002	Shalom Levi	1268-083A	2222

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EXAMINER	
TRAN, SUSAN T	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,727	LEVI ET AL.	
	Examiner	Art Unit	
	Susan T. Tran	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-8,10-13,19-26 and 28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-8,10-13,19-26 and 28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of applicant's Amendment filed 03/30/04.

Upon further search and consideration of the patentability of this application, the indicated allowability of claims 23 and 24. Accordingly, this office action is made non-final in view of the new rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5-8, 11, 19-20, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. US 4,909,986.

Kobayashi teaches aqueous deodorant composition comprising water-soluble polymer having molecular weight higher than 15,000, perfumes, citric acid, and other additives (columns 1-2, and column 7, lines 56-620). The water-soluble polymer can be selected from nonionic, anionic, cationic, or amphoteric, including polyacrylic acid or polyacrylamide (columns 5-7, and examples). The aqueous deodorant composition can be applied by spraying onto liquid or solid selected from cattle raising farm, chicken farm, and livestock product, which has malodor and/or gives off malodors (column 12, lines 6-28).

The examiner notes the use of the transitional phrase "consisting essentially of" in claim 1. However, since the prior art composition has the same basic and novel characteristic (aqueous deodorant to remove malodors from animal farm), it is an applicant's burden to establish that other additives in the prior art composition are excluded from the claim by "consisting essentially of" language. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ at 1355. Furthermore, even when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

It is noted that the reference does not teach that the composition facilitating easy handling of said deodorized excrement recites in claim 21, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

Kobayashi does not teach the claimed amount of the water-soluble polymer. However, generally, differences in concentration or temperature will not support the

patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation modify the aqueous deodorant composition of Kobayashi with the expectation of at least similar result. The reason is Kobayashi teaches the use of the same water-soluble polymer and the same acid agents for the same purpose, *e.g.*, to remove malodors from livestock.

Claims 1, 2, 5-8, 10, 11 and 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. US 4,909,986, in view of Suzuki US 5,004,600.

Kobayashi is relied upon for the reason stated above. Kobayashi does not expressly teach the amount of the water-soluble polymer.

Suzuki teaches an aqueous composition comprising deodorizing agents comprising water soluble polymer, including cellulose and polyvinyl alcohol (column 2, lines 5-10). The composition is useful for the treatment of air or other gases for the removal of odors (column 1, lines 67 through column 2, line 1). The amount of the water soluble polymer is from about 35 to about 65 parts by weight, or more preferably about 20 part by weight (column 2, lines 1-4, and table 1). Thus, it would have been obvious for one of ordinary skill in the art to modify the aqueous deodorizing composition of Kobayashi using the water-soluble and the amounts of water-soluble

polymer in view of the teaching of Suzuki with the expectation of providing an aqueous deodorizing composition suitable to remove malodor in the environment.

It is noted that the cited references do not teach the pH of about 1.5. However, it is also noted that Kobayashi uses the claimed of amount of the same acidic agent, namely, citric acid (column 7, lines 56-60, and examples) to obtain an aqueous deodorizing composition suitable to remove malodor in cattle raising farm, chicken farm, or livestock product. Kobayashi also shows in example 56 shows the use of citric acid to adjust the pH of the composition. Furthermore, the examiner is unable to recognize the unexpected and/or unusual results in the particular pH value over the aqueous deodorant composition of Kobayashi. Accordingly, it is the position of the examiner that it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine suitable pH level of the composition with the expectation of at least similar result.

Claims 11-13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., and Shimizu US 4,839,089.

Kobayashi is relied upon for the reasons stated above. The reference is silent as to the specific perfume, such as limonene.

Shimizu teaches deodorant composition comprising perfume selected from alpha-pinene, terpenoid, and limonene (column 6, lines 34-36). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare Kobayashi's deodorant composition using limonene as perfume in view of the teaching of Shimizu,

because the references teach the use of perfume to reduce malodors. The expected result would be an aqueous deodorant composition that exhibits a deodorizing effect on liquids and solids, which give off odors.

Claims 1, 5-8, 10, 19-22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. US 5,882,638.

Dodd teaches aqueous odor-absorbing composition comprising citric acid and water-soluble polymer having molecular weight higher than 15,000, *e.g.*, polyacrylic acid (columns 6-7). Dodd does not teach the use of the composition on animal excrement, and/or composition facilitating easy handling of said deodorized excrement. However, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

Response to Arguments

Applicant's arguments filed 03/30/04 have been fully considered but they are not persuasive.

The Declaration filed on 09/22/03 under 37 CFR 1.131 or 1.132 has been considered but is ineffective to overcome the Kobayashi reference. The Declaration fails to provide a side-by-side comparison showing unexpected and/or unusual results of the claimed invention over that of Kobayashi.

Applicant further alleges that the upper limit of polymer taught by Kobayashi is still lower than the claimed lower limit of 0.1%. However, applicant's attention is called to example 55, where Kobayashi discloses a composition comprises 0.1 [%] aqueous solution of the polymer.

Applicant argues that the acids taught by Kobayashi are neutralized as their alkali metal or calcium salts, and therefore, does not disclose the claimed invention, "a carboxylic acid in free form". Contrary to the applicant's argument, the salts of acids taught by Kobayashi in column 8 is one of his *prefer* embodiments, many acids uses in Kobayashi are free form (columns 7-8).

Applicant argues that the applied references fail to disclose, teach or suggest the Markush group limitation recited in claim 1. Contrary to the applicant's argument, Kobayashi does teach the water soluble in the Markush group recited in claim 1, which is polyacrylamide (table 1 and examples).

Applicant argues that the applied references fail to disclose, teach or suggest the Markush group limitation recited in claims 21 and 22. Contrary to the applicant's

argument, Suzuki does teach the claimed water soluble in the Markush group recited in claims 21 and 22, which is polyvinyl alcohol or water-soluble cellulose derivatives (column 2, lines 8-10).

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jha et al., Hanford et al., Barenberg et al., and Ochomogo et al. are cited as of interest for the teachings of deodorant composition comprising about 0.1-3% film forming polymer.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (571) 272-0606. The examiner can normally be reached on M-R from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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